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IN THE

Supreme Court of the United States

OCTOBER TERM, 1996

HONEYWELL, INC.,

Petitioner,

v.

LITTON SYSTEMS, INC.

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

BRIEF OF RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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BRIEF OF RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

In its petition for writ of certiorari, Honeywell urges this Court to "hold" the instant petition pending the disposition of *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, No. 95-728 (argued Oct. 15, 1996). Honeywell also presents two further questions for this Court's review, both of which are not in fact presented by this case and in any event lack merit. Honeywell's requests should be rejected.[1]

Initially, review is inappropriate because of the procedural posture of this case. Honeywell seeks interlocutory review of the Court of Appeals' decision. This case is not final for purposes of this Court's review: The Federal Circuit has remanded the case for further proceedings in the district court.

Honeywell's petition would not warrant review in any event. Honeywell attempts to manufacture a superficial resemblance between this case and *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.* by mischaracterizing the facts and procedural history of this case. In fact, in the courts below, Honeywell accepted the traditional view of the doctrine of equivalents outlined in *Graver Tank & Manufacturing Co. v. Linde Air Prods.*, 339 U.S. 605 (1950). It did not argue for the dramatic narrowing of the doctrine of equivalents that it now advocates. Although Honeywell made a motion for judgment as a matter of law under *Graver Tank*, it agreed to submit to the jury the question of infringement under the doctrine of equivalents. There was no dispute below that the jury was properly instructed on the doctrine of equivalents.

Further, the result in this case would not change even if the doctrine of equivalents were narrowed as Honeywell seeks. The record in this case demonstrates that all of the criteria that Honeywell includes in its first Question Presented are fully

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[1] Pursuant to Rule 29.6 of this Court's Rules, Litton Systems, Inc. states that it has no parent company and one nonwholly owned subsidiary, Litton Industries, Inc.

satisfied here. Moreover, any material narrowing of the doctrine of equivalents in *Hilton Davis* could not be applied retroactively to destroy a distinct element in the bundle of rights in existing intellectual property. Any narrowing of the doctrine of equivalents thus would not require reconsideration of the patent infringement ruling here.

Moreover, even if liability for patent infringement were modified by this Court, judgment in Litton's favor would independently stand based on liability under two California state claims of interference with contract and interference with prospective economic advantage. This is not exclusively a patent case. It is a state-law tort case in which patent infringement is an additional claim. Honeywell obtained Litton's technology by inducing Litton's exclusive second source to breach its contract. The Federal Circuit specifically made clear that "the majority does not premise its conclusion regarding the state law claims on the existence of a patent." Pet. App. 22a n.3.[2]

This Court has previously denied certiorari in a number of doctrine of equivalents cases, rather than holding them in abeyance pending the decision in *Hilton Davis*.[3] For example, one of the questions presented in *BP Chemicals Limited v. Hoechst Celanese Corp.*, No. 95-2033, was:

> Whether, as this Court must decide in *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, No. 95-728, the doctrine of equivalents remains a viable legal doctrine under the Patent Act of 1952 and, if so, whether the proper legal standards for application of the doctrine were employed in this case.

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[2] References to the Appendix to the Petition for Certiorari are styled "Pet. App. _." References to the '849 patent file history lodged by Honeywell with this Court are styled ("Pat. File __"). References to the Joint Appendix in the Court of Appeals are styled "Ct. App. A _."

[3] The petition for certiorari in *Hilton Davis* was granted on Feb. 26, 1996. 116 S. Ct. 1014 (1996).

Pet. for Cert. at i (filed June 17, 1996). Nonetheless, this Court denied certiorari on October 7, 1996. 117 S. Ct. 275 (1996).

In *Showa Aluminum Corp. v. Modine Mfg. Co.*, No. 95-1557, the sole question presented was:

> Whether patent infringement exists whenever the accused product or process is "equivalent" to the invention claimed in the patent, in that the differences are not "substantial" as determined by a trier of fact, even though the accused product or process is outside the literal scope of the patent claim, and even if equitable considerations provide no reason for expanding the patent's coverage beyond the literal scope of the claims.

Pet. for Cert. at i (filed Mar. 2, 1996). Nevertheless, this Court denied certiorari on June 17, 1996. 116 S. Ct. 2523 (1996).

Certiorari should also be denied here. Indeed, there are powerful reasons for not prolonging this procedural manuevering any further while the damages trial on remand proceeds. The jury's liability verdict that Honeywell *intentionally* interfered with Litton's contractual and business relations and *willfully* infringed Litton's patent has now been upheld by the Federal Circuit. Honeywell's argument that the doctrine of equivalents is "unpredictable" and denies competitors clear notice of the scope of a patented invention (Cert. Pet. 17) is theoretical and utterly pretextual, because in *this* case it is undisputed that Honeywell *never* submitted an opinion of patent counsel to the jury to suggest that Honeywell reasonably believed that it was not infringing. Thus, there is no evidence in this case that any patent counsel was unable to predict the result herein merely by examining the file history of the patent.

This case involves *deliberate* wrongful action on the part of Honeywell. Despite this, Honeywell has so far been successful in denying a final resolution of this proceeding, which began seven years ago and included a three-month trial, with three and a half weeks of jury deliberation. The verdict was returned more

than three years ago, the patent will expire in 1998, and on January 9, 1997 the district court declined to impose an injunction against Honeywell — thus permitting Honeywell to continue its willful infringement.

Litton is entitled, after seven long years, to an end to Honeywell's delaying tactics and to reach a final conclusion in this case.

COUNTERSTATEMENT OF THE CASE

1. The RLGS Industry. Litton and Honeywell are the primary companies in the world selling sophisticated ring-laser gyroscope systems (RLGS) for commercial aircraft. These devices provide navigational control for airplanes by sensing two counter rotating laser beams reflected around a ring formed by almost perfectly (99.999%) reflective mirrors. Pet. App. 2a. In flight, there are three axes of rotation to sample, and hence there are three gyroscopes in each RLGS. *Id.* Without the nearly perfect mirrors, the RLGS will not perform satisfactorily. *Id.* In contrast, ordinary bathroom mirrors are hundreds of times less efficient. *Id.* at 53a. The highly reflective mirrors used in RLGS are made by depositing very thin layers of reflective material on a substrate, using the ion beam method. *Id.*

Prior to this litigation, Honeywell praised Litton's ion-beam method as the critical feature needed for reliable RLGS and credited Litton with discovering the method. Pet. App. 14a-15a. Honeywell admitted, in a pre-suit memorandum, that it copied Litton's method. *Id.* (outlining plan to "duplicate" Litton's method). Honeywell also acknowledged that it expected to "'get large lawsuit.'" *Id.* at 23a.

2. The Development of Litton's Technology. The RLGS industry had been searching for 99.999% reflective mirrors since the industry began its development in the 1960s. Conventional wisdom taught that the then state-of-the-art electron beam (e-beam) deposition could create an excellent mirror and, if it could be improved, would be the ideal method to make the almost

perfect mirrors needed for RLGS. Pet. App. 53a. Rockwell, Honeywell and other competitors—but not Litton—subscribed to this belief.

By the early 1980s, Honeywell found that the e-beam technology of the 1970s had problems. Mirrors resulting from e-beam deposition suffered from voids, impurities, crystallization and surface roughness. Pet. App. 54a. These defects in turn caused problems such as the phenomenon of "backscatter," in which the laser beam is not reflected perfectly but instead turns backwards, altering the critical measurements when used in RLGS. *Id.* Honeywell and other companies had repeatedly tried to build durable e-beam mirrors, but failed. *Id.* at 16a. For almost two decades, the industry sought dependable mirrors for RLGS, until Litton's ion-beam technology satisfied that need. *Id.*

Unsatisfied that the conventional e-beam technology was the best one could do, Litton scientists Wei and Hutchings experimented with ion beam sputtering beginning in 1974, in an attempt to make highly reflective mirrors. This Litton project was contrary to the advice of Prof. Baumeister—a well-known academic optical coating scientist —who recommended *against* Litton's pursuing the proposed ion beam method. Ct. App. A6947-48. Baumeister instead advised Litton to use the e-beam deposition that his university team had used to make what was, up until Litton's invention, the most reflective mirror ever made. *Id.* Similarly, Dr. Scott, a technical expert at the Department of Defense supervising the RLGS development of defense contractors, thought Litton was wasting its time with ion beam deposition. Ct. App. A1748-59.

In July 1976—after almost a year of design and construction and a year and half after his conception—Wei's experimental ion beam coating chamber was used to make Litton's first prototype mirrors. These mirrors had far less backscatter than earlier e-beam mirrors and had a previously unobtainable reflectivity of 99.63%. Ct. App. A2374. That success prompted Wei to file an invention disclosure in September 1976 with Litton's in-house

patent attorneys. Pet. App. 59a. Two months later, in November 1976, Wei left Litton. *Id.* at 60a. Shortly before Wei's departure, however, Litton hired Louderback, who succeeded during his employment at Litton in refining and commercializing Wei's ion beam process. *Id.*

3. The '958 Parent Patent. On April 13, 1978, Litton filed a patent application on a method for using ion beams to coat a substrate with multiple layers of materials to form a mirror. Pet. App. 2a. Litton's application named Wei and Louderback as co-inventors. The patent issued on March 6, 1979.

4. The Litton-Louderback Contractual Relationship. After Litton's '958 patent issued, Honeywell tried to hire Louderback for his knowledge of the Litton process but he declined employment. Instead, Louderback established his own business with Litton's financial and technical assistance. He entered into a license and exclusive consulting agreement with Litton so that he could become Litton's second source of RLGS mirrors using Litton's know-how. Pet. App. 3a. Under that license agreement, Louderback and his company agreed not to use Litton's technology to make mirrors for RLGS for anyone other than Litton. *Id.* Until February 25, 1983, Louderback was also party to an exclusive consulting agreement with Litton, which specifically provided that Litton would own any improvements or modifications Louderback conceived which related to the RLGS mirrors or the patented process. *Id.* The know-how could not be disclosed to, or used by, anyone other than Litton. *Id.* The agreement specifically prohibited disclosure to Honeywell. *Id.* During the exclusive consulting agreement with Litton, Louderback made modifications and improvements to the Litton process by using the ion gun to create RLGS mirrors that had a continuously varying index of refraction using gradient interfaces between the layers of the mirror. *Id.* Louderback's lawyer, the jury, and the Court of Appeals found that, under the terms of the consulting agreement, these improvements were Litton's property, whether or not patented. *Id.*

5. Honeywell's RLGS Problems. In 1983, Honeywell's

RLGS with e-beam mirrors began to suffer reliability problems. Pet. App. 4a. Boeing rejected over twenty percent of Honeywell's RLGS units because of the sudden failure of the mirrors. *Id.* Honeywell's reliability problems were known to Boeing and were a cause of considerable concern. *Id.* The principal problems with Honeywell's e-beam mirrors were (1) a "photochromic mirror" problem, which caused a sudden unpredictable failure of systems in use, and (2) unacceptable reliability and lifetimes. *Id.* Honeywell recognized the urgency of its predicament and realized that, if it did not improve the mirrors, sudden photochromic failure would continue and Honeywell's reliability would fall below its guarantee to Boeing. Honeywell feared that it would have to withdraw from RLGS production if the problem was not solved. *Id.*

6. Honeywell's Need to Obtain Litton's Technology. Honeywell had unsuccessfully tried to copy Litton for years. Louderback was Honeywell's *only* potential source for the technology needed for ion beam coated mirrors in 1985. Honeywell knew that, to solve the sudden failure of its RLGS on Boeing airplanes, it *had* to use Litton's mirror coating process. Pet. App. 4a. Committed to obtaining ion beam mirrors so it could salvage its billion-dollar contractual relationship with Boeing, Honeywell set out to induce Louderback to manufacture ion beam mirrors for Honeywell and to transfer the technology Honeywell needed to make the mirrors themselves. *Id.*

Honeywell documents indicate that Honeywell was aware that: (1) Louderback had license agreements with Litton; (2) Louderback "cannot make coatings for anyone other than Litton"; (3) "Litton will sue if we order production quantity [of mirrors from Louderback]"; (4) "Lauderbach [sic] has admitted to Litton trade secrets in taking license" such that "[i]f we [Honeywell] buy or license process we are liable! . . . Can get large lawsuit!"; (5) "Litton owns idea of 'IB gyros'"; and (6) "Issue may be 'proprietary' rather than patent." Pet. App. 23a. Simply put, Honeywell knew it was taking Litton's know-how but deliberately disregarded Litton's rights.

7. Honeywell Pirates Litton's Technology. To keep Boeing and avoid a "catastrophe," Honeywell approached Louderback to supply it with Litton's mirrors. Pet. App. 24a. Louderback did not want to assume such a risk and, to allay his fears of suit by Litton, Honeywell reassured him that it would support him if Litton filed suit. *Id.*

As a result of Honeywell's April 1985 adoption of Litton's ion beam process from Louderback, Honeywell (1) ultimately solved its sudden photochromic failure and its reliability problems, and (2) succeeded in renegotiating its prior contracts with Boeing to exclude Litton, the only other qualified supplier, from the market.

8. The '849 Reissue Patent. In the early 1980s, during litigation with another party, prior art that was not before the Patent Office during the prosecution of the '958 patent came to the attention of Litton. Litton then voluntarily sought to reissue the patent over all prior art of which it was aware and provided the Patent Office with the additional prior art and a patentability report.

During the prosecution of the application for the '849 reissue patent, the examiner rejected the claims as obvious in view of the Bernard patent, which had described ion sputtering of a semiconductor film using an ion beam generated by a *duoplasmatron*. Pat. File at 108. In response, Litton argued that "[d]uoplasmatron sources emit small area beams, and produce very slow rates of deposition" and that "a duoplasmatron is impractical for making multiple layer optical films [mirrors]." *Id.* at 148-149. Litton thereby distinguished only the *narrow beams* made from a duoplasmatron from the *broad beams* made from a Kaufman-type source. In support of this position, Litton submitted an expert declaration distinguishing the narrow ion beams of duoplasmatrons from broad ion beams of Kaufman-type sources. *Id.* Litton also argued to the examiner that those skilled in the art would reasonably construe the claims to refer to the beams from Kaufman-type gridded ion beam sources, because such persons would recognize that the *narrow* beams

from a duoplasmatron would not be practicable. *Id.* at 149. The examiner then withdrew the § 103 rejection, but stated that he would issue a § 112 rejection if the implicit "Kaufman-type" language were not made explicit in the claims. *Id.* at 205. Litton complied. Both the district court and the Federal Circuit found that Litton had distinguished only the narrow beam made from a duoplasmatron, and neither accepted Honeywell's argument that RF sources had been "implicitly" disclaimed. Pet. App. 20a, 134a-135a. There were no references to RF sources in the arguments of Litton or the comments of the examiner.

The PTO reissued the patent on January 31, 1989. Ct. App. A9831-39. Although Honeywell attempts to create the impression that Litton misled the PTO during the patent prosecution (Pet. 8), the Court of Appeals *unanimously* rejected all of Honeywell's allegations of inequitable conduct. Pet. App. 16a-19a; *id.* at 34a (Bryson, J., concurring in relevant part).

Litton's '849 reissue patent contains over 20 separate patent claims, each of which was found to be infringed by the jury and the Court of Appeals. Each claim is a multistep process including numerous components other than the ion beam "produced or derived from a Kaufman-type ion beam source." As noted in the specification, the preferred ion beam is created by a gun with "multiple apertured grids," which attract molecules of an ionized gas and then project the ions as a low energy neutralized beam. The beam in turn displaces material, atom by atom, from one of at least two targets. The atoms are then deposited one at a time on a substrate or mirror base to form over 20-30 layers, each only a few atoms thick. The patent claims require this mirror-making process to take place in a controlled atmosphere to assure proper "stoichiometry," or oxidation of the material used to form the mirror. Thus, while the characteristics of the ion beam formed by the Kaufman grids is important, the method by which gas is ionized for the grids is unimportant to the mirror maker. The co-inventor of the Kaufman gun, Paul Reader, testified that ion beams formed by the Kaufman grids will be identical regardless of whether cathodes or RF energy are

used to ionize the gas for the Kaufman grids. Ct. App. A1528.

The Litton specification depicted a Kaufman-type gun with a wire cathode as the preferred embodiment in the patent specification because it was the *only* commercially available Kaufman-type source in the United States in 1978. Pet. App. 20a. Thus, Litton's "claims recited 'Kaufman-type' to distinguish this ion beam source from a duoplasmatron" — the only other available source at the time of the original application. *Id.* at 20a. In later years, commercial Kaufman-type sources were developed that used other means to create the ions, including hollow cathode and RF ionization, to reduce the need to replace cathodes; these other sources still used the Kaufman-type grids to attract, form, and project the ion beam. *Id.* at 21a.

Both an ion gun with RF ionization and a Kaufman-type ion beam source generate the required ion beam in the same way — by removing electrons from gas molecules to create ions that are in turn formed by Kaufman-type grids into an ion beam. The ion beam itself is formed in exactly the same way from the ionized gas, regardless of the means of ionization.

9. The Litigation to Date. Litton filed the complaint in this action on January 7, 1990 against Louderback for infringement of the '849 reissue patent and for breach of the license agreement previously extended by Litton to Louderback. Litton alleged that Louderback used Litton's own technology to make RLGS mirrors for Honeywell and that Louderback had transferred to Honeywell the technology it needed to make the mirrors itself. The complaint was later amended to assert, *inter alia*, (1) patent infringement claims against Honeywell, Litton's only competitor in the sales of commercial RLGS, and (2) two state law tort claims against Honeywell for intentional interference with the Litton-Louderback contract and with Litton's prospective economic advantage.

After three months of trial and three and a half weeks of jury deliberations, on August 31, 1993 the jury answered a detailed 19-page stipulated Jury Verdict form. In doing so, the jurors unanimously found Honeywell's infringement willful and, in

their own handwriting, wrote that "Honeywell did use wrongful means" intentionally to interfere with Litton's prospective economic advantage. Pet. App. 24a (original emphasis).

Eighteen months after the jury verdict, the district court determined as a matter of law that Honeywell did not infringe the '849 reissue patent, either literally or under the doctrine of equivalents. Pet. App. 2a. In doing so, however, the district court rejected Honeywell's "prosecution history estoppel" argument, remarking that: "Thus, although Litton might now be estopped to claim duoplasmatron sources, placing the [patent] examiner's actions in context, it is arguable that Litton should not be estopped to claim some other ion beam sources as equivalents." Pet. App. 135a. The district court also granted Honeywell's motion for judgment as a matter of law on the two independent state law claims and granted a new trial on damages. *Id.*

On appeal, the Court of Appeals for the Federal Circuit reversed the JMOL on infringement and on the two state claims, but affirmed the grant of a new trial on damages. Pet. App. 33a-34a. Honeywell's subsequent petition for rehearing and suggestion for rehearing in banc were both denied. In each instance, the Court of Appeals rejected the same mischaracterized prosecution history estoppel arguments that Honeywell now urges in this Court. Specifically, in rejecting Honeywell's argument that the scope of the patent claims was limited to a method using the particular Kaufman-type gun described in the patent specification, the Court of Appeals stated:

> The claims require a "Kaufman-type" source, not a Kaufman ion gun. At the time of the original Louderback-Wei application, the claims recited "Kaufman-type" to distinguish this ion-beam source from a duoplasmatron — the other available source at the time.

Pet. App. 20a. The Court recognized that "[b]y the 1990s, the beam art advanced to include RF ionization as substitutes for the

earlier Kaufman guns." *Id.* at 21a.

The Federal Circuit also noted that, unlike the duoplasmatron (which produced a narrow beam), "Honeywell's RF ion-beam source produced a beam and a result substantially similar, if not *identical*, to the Kaufman-type ion beam." Pet. App. 21a (emphasis added). The court's conclusion is amply supported by the record evidence. The inventor of the RF ionization gun, Oechsner, testified that the physical properties of the ion beam produced by a Kaufman-type gun would not differ from those of the ion beam produced with a wire cathode, or from the physical characteristics of the ion beam produced using RF ionization. Ct. App. A8078-81, A8116-18, A8184-85. The co-inventor of the Kaufman gun, Reader, agreed. Ct. App. A1528. Litton's witnesses testified that the beams and resulting mirrors from Kaufman-type sources with and without RF ionization are *indistinguishable*. Ct. App. A1160-62, A1525-28, A1460. Honeywell itself admitted that the resulting mirrors are "gun neutral." Ct. App. A11108.

Neither in the district court nor in the Court of Appeals did Honeywell argue what it now urges in its petition: that for the doctrine of equivalents to apply (a) the patent must disclose the equivalent method, and (b) the equivalent method must be known at the time the patent application was filed. (*See* Notice of Motion and Motion of Honeywell for Judgement as a Matter of Law, September 27, 1993).

Honeywell filed a motion in the Federal Circuit seeking a stay of that court's judgment pending the filing and disposition of a petition for certiorari. That motion was denied. Honeywell subsequently filed in this Court an application for stay of the Federal Circuit's judgment pending disposition of Honeywell's petition for certiorari. A 96-223 (filed Sept. 26, 1996). That application was based on the same arguments recycled here. It was denied by the Chief Justice by Order of October 2, 1996.

Currently, this case is on remand to the trial court, awaiting a new trial on damages and further proceedings. Litton's request for injunctive relief and Honeywell's request to excuse its

infringement on the ground of equitable intervening rights were denied on January 9, 1997.

I. THE INTERLOCUTORY NATURE OF THIS CASE COUNSELS AGAINST REVIEW

At the outset, review is inappropriate here because this case is interlocutory in nature. This case is not final for purposes of this Court's review. The Federal Circuit has remanded this case for further proceedings in district court, including a new trial on damages. Under these circumstances, this Court normally declines to exercise its certiorari jurisdiction, in order to conserve judicial resources and to avoid addressing unnecessary questions. *E.g., Virginia Military Institute v. United States*, 508 U.S. 946, 946 (1993) (opinion of Scalia, J., respecting the denial of certiorari) ("We generally await final judgment in the lower courts before exercising our certiorari jurisdiction."); *Brotherhood of Locomotive Firemen v. Bangor & Aroostock R.R.*, 389 U.S. 327, 328 (1967) (*per curiam*).

II. THIS COURT SHOULD NOT HOLD THE INSTANT PETITION PENDING THE DECISION IN *HILTON DAVIS*

Honeywell urges that the instant petition be held pending the decision in *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, No. 95-728. But this Court has already declined to follow that approach with respect to a number of petitions in doctrine of equivalents cases. *See* pp. 2-3, *supra*. There are especially powerful reasons not to entertain Honeywell's arguments here.

1. Nowhere in its petition does Honeywell set forth where in the lower courts it raised the ambitious challenges it now raises to the doctrine of equivalents or to prosecution history estoppel. That omission is not surprising, for until now Honeywell never sought the dramatic change to these doctrines that it opportunistically urges for the first time in this Court. Although

Honeywell made a motion for judgment as a matter of law under *Graver Tank*, it agreed to submit to the jury the question of infringement under the doctrine of equivalents. This case has been tried, briefed, and argued under a legal rubric that Honeywell now conveniently tries to disavow.

In such circumstances, this Court ordinarily declines to review a question not raised or resolved in the lower courts. This practice "help[s] to maintain the integrity of the process of certiorari." *Taylor v. Freeland & Kronz*, 503 U.S. 638, 646 (1992). That process is not a lottery designed for the convenience of sore losers who suddenly decide to play a newly discovered card. Indeed, "[t]he rule that points not argued will not be considered is more than just a prudential rule of convenience; its observance, at least in the vast majority of cases, distinguishes our adversary system of justice from the inquisitorial one." *United States v. Burke*, 504 U.S. 229, 245 (1992) (Scalia, J., concurring in the judgment). Hence, whatever this Court decides in *Hilton Davis*, it would be inappropriate to consider Honeywell's arguments.

Petitioner attempts to excuse its procedural default by suggesting (Pet. 23) that the Federal Circuit's decision in this case somehow departs from the "function-way-result" test of *Graver Tank*. That is false. The Court of Appeals expressly invoked the traditional legal standard, as Honeywell itself urged. Pet. App. 20a. The Federal Circuit found that "the record showed that Honeywell's RF ion-beam source produced a beam and a result [mirrors] substantially similar, if not identical, to the Kaufman-type ion beam" *Id.* "Experts similarly testified to the known interchangeability of an RF source with a 'Kaufman-type' source at the time of infringement." *Id.* Even Judge Bryson, on whose opinion Honeywell heavily relies, acknowledged that "the RF source performs the same function as the Kaufman-type source." *Id.* at 37a (opinion dissenting in relevant part). Judge Bryson was misled into believing that Honeywell had proffered an opinion of counsel that RF ion sources did not infringe, but the record is devoid of any such opinion, much less reliance

thereon by Honeywell.

An ion gun includes gas that must be ionized — *i.e.*, turned into charged particles by the removal of electrons. The gas can be ionized either with a cathode or with RF ionization. Once the gas is ionized, by whatever method, it is then attracted by the Kaufman-type grids to be formed into a broad ion beam needed for the mirror-making process. How the gas is ionized is immaterial to the mirror-making process. Litton experts Dr. Pulker and Dr. Scott both testified that the means by which gas is ionized is not important to a mirror-maker because the ion beams are interchangeable. Ct. App. A1348, 1463, 1896. Rather, it is the characteristics of the beam being produced that are important. Ct. App. A1348. Even the inventor of the ion guns using RF ionization admitted that the resulting ion beams are indistinguishable. Optical scientists Scott, Hutchings, Guenther, and Pulker all regarded an RF source to be a Kaufman-type source. Ct. App. A672-73, A675, A1161-62, A1347-48, A1463, A1482, A1825-27, A8079-80. The trial evidence showed that the use of RF ionization merely reduced cathode maintenance. Ct. App. A12200. Numerous experts also stated that mirrors would be indistinguishable regardless of how the gas was ionized. *See* p. 12, *supra*.

Even if, contrary to fact, the claims required an ion gun rather than an ion beam, Honeywell's arguments would still fail. Although RF ionization may not dislodge electrons to ionize gas in a manner identical to that of the Kaufman-type gun described in the specification, a complete identity in operation has never been required under the doctrine of equivalents. *Graver Tank*, 339 U.S. at 609. All that is required is substantial similarity. *Id.* at 608. That test was met here, because both an ion gun with RF ionization and a Kaufman-type ion beam source generate the required ion beam in substantially the same way.

Accordingly, the Court of Appeals properly concluded that Honeywell's use of the RF ion-beam source is "an insubstantial change, under the doctrine of equivalents" from the Kaufman-type ion-beam source described in Litton's patent. Pet. App.

21a. In short, the present case represents a clear application of the very law which, until now, has been accepted by Honeywell.

2. The result in this case would not change even under the new version of the doctrine of equivalents proposed by Honeywell. Review should therefore be denied.

Honeywell contends that patent infringement under the doctrine of equivalents may be found only where (a) the patent "discloses the equivalence of the defendant's process," Pet. i; (b) the equivalence was "known at the time of the patent," *id.*; (c) the defendant's process does not "operate in a different way from the patented process," *id.*; (d) the equivalence ruling does not "extend[] the patent's coverage beyond a specific limit that was demanded by the Patent and Trademark Office and accepted by the patentee." *Id.* While this is not and has never been the law, all these "criteria" are met here. In brief:

(a) Litton's patent claims are directed to methods that employ an ion beam with particular physical characteristics. The Honeywell gun with RF ionization produces a beam with these characteristics. Honeywell admitted that the process it used was identical to Litton's, except with respect to the method by which the gas was ionized.

(b) At trial, Honeywell itself took the view that the equivalence of RF ionization was known at the time of the patent and that Litton's patent implicitly disclaimed it. Pet. App. 78a-96a. The inventor of the RF ion gun, Oechsner, and the co-inventor of the Kaufman gun, Reader, testified that RF ion sources were known in 1978, although they were not commercially available in the United States until the early 1990s. RF ion sources were not discussed by Litton or the patent examiner.

(c) With respect to the "way" in which the patented process operated, Honeywell production documents showed that the process was "gun neutral" (Ct. App. A11108) regardless of which gun was used. The Honeywell RF gun used the same Kaufman grids to produce the same beam from the gas that had been ionized. The only difference between the guns was the

unimportant detail of how the gas was initially ionized. This related to cathode maintenance, not the characteristics of the ion beam.

(d) With respect to prosecution history estoppel, Honeywell simply misstates the file history before the Patent and Trademark Office. As confirmed by both the district court and the Federal Circuit, *see* pp. 8-10, 16, *supra*, Litton was asked to distinguish the ion gun it used from the narrow beam duoplasmatron utilized in the prior art to make non-optical coatings. Honeywell is not using the narrow beam ion source that Litton distinguished. Instead, Honeywell uses a broad beam ion source whose beam is identical to that produced by the Kaufman-type ion-beam source described in Litton's patent

Both the Federal Circuit and the district court rejected Honeywell's argument and the record demonstrates that no estoppel exists. Pet. App. 20a, 135a. Honeywell ignores the fundamental fact that the claims at issue are drawn to a *method* for making multiple layer optical films (mirrors), using ion beam deposition techniques, *not* to an ion gun. As noted by the Court of Appeals, the claims at issue have as a limitation an "ion *beam* produced or derived from a Kaufman-type ion beam source." Pet. App. 5a, 21a (emphasis added). Honeywell's mirror-coating process results in mirrors that are "substantially similar, if not identical" to those obtained using a Kaufman-type ion-beam source. *Id.* at 21a.

3. Review should also be denied because of the state-law claims on which the jury returned verdicts for Litton and which have now been upheld by the Federal Circuit. These claims for intentional interference with contract and intentional interference with prospective economic advantage are wholly matters of state law, which this Court lacks jurisdiction to review under *Murdock v. Memphis*, 87 U.S. 590 (1874). The state law claims stand apart from the patent claims, as the Federal Circuit recognized. Pet. App. 22a n.3. Those claims provide an independent basis for relief that does not turn on patent law. *See Michigan v. Long*, 463 U.S. 1032, 1042 (1983).

4. Review should be denied for the further reason that any restriction of the doctrine of equivalents by this Court in *Hilton Davis* could not be applied retroactively. This Court has long held that "rights secured under the grant of letters patent by the United States [a]re property and protected by the guarantees of the Constitution and not subject therefore to be appropriate even for public use without adequate compensation." *William Cramp & Sons Ship & Engine Bldg. Co. v. International Curtis Marine Turbine Co.*, 246 U.S. 28, 39-40 (1918). In addition, the confidential proprietary information disclosed by Litton as part of the know-how of the process is *itself* a valuable and constitutionally protected property right. *See Ruckelshaus v. Monsanto Co.*, 467 U.S. 986, 1003-04 (1984); *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 480-81 (1974).

In a very real and practical sense, part of a patentee's *property* encompasses the extant legal rules upon which he is entitled to rely to enforce his patent. The doctrine of equivalents is a significant element in that bundle of rules. Such "[i]nvestment-backed expectations" are the essence of private property rights. *Penn Central Transp. Co. v. City of New York*, 438 U.S. 104, 124 (1978).

To alter, retroactively, the terms on which a patent is granted would work an obvious taking of private property. *See, e.g., Richmond Screw Anchor Co. v. City of New York*, 275 U.S. 331, 345 (1928). Hence, any substantial contraction of the doctrine of equivalents would defeat the settled expectations of existing patent holders, and any decision in *Hilton Davis* restricting the doctrine of equivalents could be applied only prospectively. No more by judicial decree than by legislative fiat may government take private property without compensation. *See, e.g., Lucas v. South Carolina Coastal Council*, 505 U.S. 1003, 1031 (1992); *Webb's Fabulous Pharmacies, Inc. v. Beckwith*, 449 U.S. 155, 164 (1980); *Hughes v. Washington*, 389 U.S. 290, 298 (1967)

(Stewart, J., concurring).[4]

5. On the merits, Honeywell's attempt to effect a radical revision of the doctrine of equivalents should be rejected. This Court has already rejected Honeywell's arguments, when they were raised in dissent by Justice Black in *Graver Tank*, 339 U.S. at 613-17 (dissenting opinion). They have not become more persuasive with the passage of time and the settling of patentees' expectations. As the United States has observed, changes of the kind sought by Honeywell would eviscerate the ability of the doctrine of equivalents to protect patentees from infringement. Br. of the United States as Amicus Curiae in No. 95-728, at 21-23 & n.7

In addition, Honeywell's argument flies in the face of longstanding precedent. For example, contrary to Honeywell's suggestion (Pet. 22-23), it is well established that the doctrine of equivalents is not limited to equivalents disclosed in the patent. Indeed, "[i]n order to be an equivalent of another, it is not necessary that the device have been known at the time of the machine which contains the latter." 6 LIPSCOMB'S WALKER ON PATENTS §§ 22:34-22:40, at 541-56 (3d ed. 1987).[5] This Court has held that a later improvement, even if patented, may still violate the doctrine of equivalents if it satisfies the function-way-result test. *See Sanitary Refrigerator Co. v. Winters*, 280 U.S.

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[4] The doctrine of equivalents is judicially created. Altering it prospectively would present none of the jurisprudential tensions that arise when a prospective-only ruling amounts to a denial that a text — either the Constitution itself, as in *Harper v. Virginia Dept. of Taxation*, 509 U.S. 86 (1993), or a federal statute, *see Plaut v. Spendthrift Farm, Inc.*, 115 S. Ct. 1447, 1451 (1995) — has had the same meaning since its enactment.

[5] *See Cantrell v. Wallick*, 117 U.S. 689, 695 (1886); *Clough v. Barker*, 106 U.S. 166, 177-78 (1882); *Machine Co. v. Murphy*, 97 U.S. 120, 125 (1878); *Cochrane v. Deener*, 94 U.S. 780, 790 (1877); *Mason v. Graham*, 90 U.S. 261, 275 (1875); *Burr v. Duryee*, 68 U.S. (1 Wall.) 531, 573 (1864); *O'Reilly v. Morse*, 56 U.S. 62, 123-24 (1854); *Texas Instruments, Inc. v. United States Int'l Trade Comm'n*, 805 F.2d 1558, 1563 (Fed. Cir. 1986); *SRI Intern. v. Matsushita Corp. of Am.*, 775 F.2d 1107, 1121 (Fed. Cir. 1985) (*en banc*).

20, 40, 43 (1929) (reaffirmed in *Graver*, 339 U.S. at 608); *see also Atlas Powder Co. v. E.I. Du Pont De Nemours & Co.*, 750 F.2d 1569, 1580-81 (Fed. Cir. 1984). The patent owner is not expected to "predict all future developments which enable the practice of his invention in substantially the same way." *Hughes Aircraft Co. v. United States*, 717 F.2d 1351, 1362 (Fed. Cir. 1983). Otherwise, unforeseeable technological developments would in effect sweep away existing patents altogether. "The law does not require the impossible. Hence, it does not require that an applicant describe in his specification every conceivable and possible future embodiment of his invention." *SRI Intern. v. Matsushita Corp. of America*, 775 F.2d 1107, 1121 (Fed. Cir. 1985) (*en banc*).

Similarly, Honeywell's argument with respect to prosecution history estoppel reflects cavalier disregard of the careful development of the law in the Federal Circuit designed to assure predictability in the enforcement of patents. It is well settled that prosecution history estoppel prevents a patentee from reclaiming, through the doctrine of equivalents, what was willfully surrendered before the Patent Office to exclude prior art embodiments that would otherwise have invalidated the patent. It is also well settled that amendments made to describe a claimed invention more specifically, in response to a rejection under 35 U.S.C. § 112, do not result in a prosecution history estoppel. *Caterpillar Tractor Co. v. Berco, S.p.A.*, 714 F.2d 1110, 1115 (Fed. Cir. 1983).[6]

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[6] *See, e.g., Laitram Corp. v. NEC Corp.*, 952 F.2d 1357, 1358 (Fed. Cir. 1991); *Insta-Foam Products, Inc. v. Universal Foam Systems, Inc.*, 906 F.2d 698, 703 (Fed. Cir. 1990); *Moeller v. Ionetics, Inc.*, 794 F.2d 653, 658-60 (Fed. Cir. 1986); *Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861, 871 (Fed. Cir. 1985); *Hughes Aircraft Co. v. United States*, 717 F.2d 1351, 1362 (Fed. Cir. 1983); *Omark Indus., Inc. v. Textron*, 688 F.2d 1242, 1251-52 (9th Cir. 1982).

III. THE SECOND QUESTION DOES NOT WARRANT THIS COURT'S REVIEW

Honeywell's second question is nothing more than a fact-specific application of settled legal doctrines. The question bears no relation to any of the issues in *Hilton Davis*, and Honeywell does not contend otherwise. Review should be denied.

The Court of Appeals held, based on the correct legal standard, that the jury's verdict of infringement by equivalents by Honeywell's RF ion-beam process should be reinstated because it was supported by substantial evidence. Pet. App. 20a-21a. Honeywell objects that the Court of Appeals should have ordered a new trial rather than reinstating the verdict. Honeywell argues that the district court's rejection of Litton's patent claim construction in the context of *literal* infringement required the Court of Appeals to vacate the verdict with respect to infringement under the *doctrine of equivalents*.

1. Honeywell erroneously assumes that the jury inconsistently used the same patent claims construction for both literal infringement and infringement under the doctrine of equivalents. Yet nothing in the instructions permitted the jury to do so. Under applicable legal principles, this Court must conclude that the jury used Honeywell's interpretation of the patent claim to find infringement under the doctrine of equivalents.

The jury was presented with both Litton's and Honeywell's definitions of the patent claims by means of a special verdict form asking the jury to determine separately whether Honeywell infringed literally or, *in the alternative*, under the doctrine of equivalents. Litton's claim construction included RF ion sources; Honeywell's did not. Ct. App. A39. In finding literal infringement by Honeywell's RF process, the jury necessarily adopted Litton's definition of the claim term "Kaufman type ion beam source": "Any broad-beam multiapertured, gridded ion beam source, which includes any hollow cathode gun and any *radio frequency gun*." Ct. App. A39 (emphasis added).

The jury was also instructed to determine equivalents "if an element disclosed in the patent is *not* present in an accused process." Ct. App. A9695 (emphasis added). Hence, in order to proceed to the question of equivalents at all after having found literal infringement under Litton's claim construction, the jury necessarily used Honeywell's narrower claim construction in reaching its verdict with respect to equivalence. Indeed, to suppose otherwise would conflict with the presumption that the jury follows its instructions. *See, e.g., Greer v. Miller*, 483 U.S. 756, 766 n. 7 (1987); *Richardson v. Marsh*, 481 U.S. 200, 206, 211 (1987). And it would also conflict with the Seventh Amendment command that the jury's answers be reconciled if it all possible. *See Gallick v. Baltimore & O. R. Co.*, 372 U.S. 108, 119 (1963) ("We therefore must attempt to reconcile the jury's findings, by exegesis if necessary, . . . before we are free to disregard the jury's special verdict and remand the case for a new trial"); *Atlantic & Gulf Stevedores, Inc., v. Ellerman Lines, Ltd.*, 369 U.S. 355, 364 (1962) ("Where there is a view of the case that makes the jury's answers to special interrogatories consistent, they must be resolved that way").

If Honeywell believed that there was anything improper about the jury's "switch[ing] gears," Pet. 27 n.12, it should have objected before the jury was dismissed. Having failed to object before the jury was discharged, Honeywell has now waived any objection on this score. "[T]he law is perfectly clear that [Honeywell] . . . waived any claim of internal inconsistency 'by failing to object after the verdict was read and before the jury was discharged.'" *Peckham v. Continental Casualty Ins. Co.*, 895 F.2d 830, 836 (1st Cir. 1990) (citation omitted); *see also Masure v. Donnelly*, 962 F.2d 128, 134 (1st Cir. 1992); *Golub v. J.W. Gant & Associates*, 863 F.2d 1516, 1520-1521 n. 4 (11th Cir. 1989); *Stancill v. McKenzie Tank Lines, Inc.*, 497 F.2d 529, 534-35 (5th Cir. 1974).

Further, the jury's "switch" in gears is hardly the "grasping at straws" that Honeywell awkwardly tries to lampoon. Pet. 27 n.12. By comparison, in *Gallick v. Baltimore & O. R.R. Co.*, 372

U.S. 108 (1963), this Court held that it was *not* inconsistent for a jury (a) to find that a railroad was negligent when foreseeability of harm was an essential ingredient of negligence, and (b) to answer the following interrogatory "No": "Was there any reason for the defendant B & O to anticipate that such (maintenance of a stagnant, infested pool) would or might probably result in a mishap or an injury?" *Id.* at 123 (Stewart, J., dissenting). This Court's decision rested on a careful parsing of the interrogatories in a manner far less natural than is called for here. 372 U.S. at 119-20. By comparison, the reconciliation here is eminently straightforward. It is a reasonable explanation for the jury's finding of both literal infringement and infringement under the doctrine of equivalents.

Because the jury used Honeywell's claim construction in deciding the equivalents question, Honeywell's argument that the verdict on infringement rests on an improper claim interpretation (Pet. 27-28) is simply false.

2. Honeywell's argument would not warrant this Court's review, even if the jury *had* reached its verdict of equivalence using an erroneous claim construction. The Federal Circuit properly accepted Litton's argument (*see* Litton Response to Honeywell Combined Petition for Rehearing and Suggestion for Rehearing *In Banc*, at 8), that under *Boyle v. United Technologies Corp.*, 487 U.S. 500, 513-14 (1988), remand is improper where no reasonable jury, under the proper legal standard, could have found for the petitioner (here, Honeywell). In this case, Honeywell failed to identify in the Federal Court any evidence contrary to the conclusion that, for purposes of producing the RLGS mirrors in the claimed process, ion beam guns using RF ionization are fully interchangeable with ion guns using wire cathodes to ionize the gas. Litton introduced testimony from a number of scientists, including Honeywell's own ion gun supplier (Ion Tech), that the resulting ion beams are indistinguishable regardless of the mechanism used to ionize the gas in the reservoir of the ion gun. As noted by all of the scientists, the Kaufman-type grids determine the characteristics

of the ion beam. Thus, a remand was not warranted under *Boyle*.

The Federal Circuit reached just such a conclusion in *Exxon Chemical Patents, Inc. v. Lubrizol Corp.*, 64 F.3d 1553, 1560 (Fed. Cir. 1995) (relying on *Boyle*). On June 24, 1996, this Court denied review in that case. 116 S. Ct. 2554 (1996). Review should similarly be denied here. The *Boyle* doctrine involves fact-specific applications of settled legal principles to particular, often *sui generis* circumstances. There are few if any precedential implications of such decisions by the courts of appeals. Consequently, there is no warrant for this Court's review.

IV. THE THIRD QUESTION DOES NOT WARRANT THIS COURT'S REVIEW

In its third question presented, Honeywell contends that, if the patent-infringement ruling is legally defective (as Honeywell's first two questions urge), then the Court of Appeals erred in upholding the jury's state-law verdicts because they "likely" rested on a finding of patent infringement. Pet. 28. Hence, if this Court determines — as it should — that the first two questions do not merit review, then it need not reach Honeywell's third question.

1. The Federal Circuit rejected Honeywell's premise that the verdict rested on a finding of infringement. The Court of Appeals indicated that "the majority does not premise its conclusion regarding the state claims on the existence of a patent." Pet. App. 22a n.3. This Court ordinarily accepts a lower court's findings as to "what occurred at the trial" and "the basis of the verdict." *Minneapolis St. P. & S. Ste. M. R. v. Moquin*, 283 U.S. 520, 521 (1931). At best, Honeywell's question raises only a fact-specific issue concerning the application of settled legal principles and does not warrant this Court's review.

2. In addition, Honeywell improperly blends together the two separate state-law causes of action. Litton sued for both (a) intentional interference with Litton's contractual relations with

Louderback and (b) intentional interference with Litton's prospective economic advantage with Boeing, McDonnell Douglas, and Airbus. Pet. App. 22a-29a. With respect to the first claim — interference with the Litton-Louderback contract — patent infringement was wholly irrelevant. The claim rested on the contractual relationship between Litton and Louderback, not on the existence or the validity of the patent, as the Federal Circuit's discussion makes clear. *Id.* at 22a-24a. Honeywell offered to indemnify Louderback when it knew he was on license to Litton, could not make mirrors for Honeywell, and had agreed that the technology he had received included Litton trade secrets. *Id.* at 24a. Hence, even if the patent infringement verdict were incorrect (and it is not), the contractual interference claim would be wholly unaffected and would remain an adequate and independent ground for the Court of Appeals' judgment.

Nor was it "likely" (Pet. 28) that patent infringement was the basis for the claim of interference with prospective economic advantage. To begin with, the Court of Appeals found that there were many nonpatent grounds for concluding that Honeywell had used "wrongful means" in competing with Litton. Honeywell misappropriated Litton's proprietary ion beam technology, and "the jury could have determined that the information was a trade secret or was entitled to protection under unfair competition." Pet. App. 22a n.3. Honeywell paid millions of dollars improperly to obtain Litton's mirrors from Litton's own exclusive second source, Louderback, in order to solve Honeywell's reliability problems. *Id.* at 24a.

Honeywell was in fact *aware* that the scope of the confidential technology it was misappropriating from Litton extended *beyond* the disclosure of the '958 patent. Internal Honeywell documents state that "Litton owns idea of 'IB gyro' . . . Issue may be 'proprietary violation' rather than patent!" Pet. App. 23a. Another Honeywell document indicated: "Louderback had admitted to Litton trade secrets in taking license. If we buy or license process we are liable! Can get large lawsuit!" *Id.* Nevertheless, Honeywell proceeded to obtain Litton's technology

and induced Louderback to breach his contract by falsely promising to indemnify him if Litton sued. Indeed, once the jury concluded that Honeywell had intentionally and tortiously interfered with Litton's contract with Louderback — a finding that necessarily rested on nonpatent grounds — it was all but compelled to determine (also for nonpatent reasons) that Honeywell had also interfered with Litton's prospective economic advantage. As the Federal Circuit made clear, "the majority does not premise its conclusion regarding the state law claims on the existence of a patent." Pet. App. 22a n.3.

Moreover, it is plain under the jury instructions that patent infringement could *not* have been the sole factor determining the jury's verdict on prospective economic relations. The jury was instructed that, because of intervening rights, there was no liability for patent infringement prior to January 31, 1989. Ct. App. A9713. The jury is of course presumed to follow the charge. *See*, p. 22, *supra*. Yet the time prior to 1989 was precisely the period when Litton's claims for interference with contract and interference with prospective economic relations accrued.[7] Accordingly, the jury did not rely solely on patent infringement in finding that Honeywell was liable under the two state-law theories.

3. Even if the jury had relied on patent infringement with respect to the state-law claims, Honeywell's argument is legally unsupported. Here, the jury answered consistently a 19-page special verdict form urged on the court by Honeywell.

This case is governed by the Seventh Amendment rule that "the judgment is to be upheld under any reasonable theory presented and supported by the evidence." *Ashley v. R.D. Columbia Assocs., L.P.*, 54 F.3d 498, 501 (8th Cir. 1995). Even Honeywell's authorities admit that, if a district court correctly instructs the jury regarding each ground of liability, the verdict must be affirmed if there is sufficient evidence to support it

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[7] Honeywell went so far as to argue in the briefs below that the state claims were limited to pre-1989 wrongdoing.

under any of the alternative grounds. *Griffin v. United States*, 502 U.S. 46, 58-60 (1991). *See also Gallick*, 372 U.S. at 119; *Tennant v. Peoria & P.U.R. Co.*, 321 U.S. 29, 35 (1944) ("It is not the function of a court to search the record for conflicting circumstantial evidence in order to take the case away from the jury on a theory that the proof gives equal support to inconsistent and uncertain inferences.").[8]

None of the authorities on which Honeywell relies is apposite here. Honeywell relies on cases involving general verdicts, not special verdicts. *E.g., City of Columbia v. Omni Outdoor Advertising, Inc.*, 499 U.S. 365, 384 (1991); *Sunkist Growers, Inc. C. Winkler & Smith Citrus Prods. Co.*, 370 U.S. 19, 29-30 (1962); *United New York & New Jersey Sandy Hook Pilots Ass'n v. Halecki*, 358 U.S. 613, 620 (1959). Honeywell also cites (Pet. 30) a series of criminal cases in which juries were charged that a defendant may be convicted liable on any of several alternative grounds. In such a criminal case, if it is ultimately determined that one of the instructions is legally erroneous, the jury verdict must be vacated. *See, e.g., United States v. Miller*, 84 F.3d 1244 (10th Cir. 1996) ("the instruction defining one of the two alternative grounds for conviction was legally erroneous"); *United States v. Pettigrew*, 77 F.3d 1500, 1510 (5th Cir. 1996) ("the district court erred in refusing to submit appellants'

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[8] *See Hiltgen v. Sumrall*, 47 F.3d 695, 700 (5th Cir. 1995) ("A jury verdict must be upheld unless there is no legally sufficient evidentiary basis for a reasonable jury to find as the jury did.") (internal quotations omitted); *Union Pac. R.R. Co. v. Lumbert*, 401 F.2d 699, 701 (10th Cir. 1968) (when a party fails to object to a jury instruction or request a special interrogatory a general jury verdict is upheld "where there is substantial evidence supporting any ground of recovery in favor of an appellee.") (citation omitted); *see also Traver v. Meshriy*, 627 F.2d 934, 938 (9th Cir. 1980) ("Where more than one theory of recovery has been submitted to the jury in a civil case, and where on appeal it is claimed that as to one of the theories there was a lack of evidential support or an error of law in submitting the theory to the jury, the reviewing court has discretion to construe a general verdict as attributable to another theory if it was supported by substantial evidence and was submitted to the jury free from error.").

requested materiality instruction"); *United States v. Vebeliunas*, 76 F.3d 1283, 1290 (2d Cir. 1996) (arguably faulty instruction upheld by court); *see also Chiarella v. United States*, 445 U.S. 222, 237 n.21 (1980).[9]

Neither of these lines of authority governs here. This is a patent infringement case, not a criminal case. Moreover, the verdict here was a special verdict, based on interrogatories drafted by the parties. It was not a general verdict. Further, Honeywell identifies no defect in any of the jury instructions given by the district court. Nor did it raise any objection at trial that would be relevant here. *See O'Neill v. Krzeminski*, 839 F.2d 9, 11 (2d Cir. 1988) ("in the absence of such particularized objection, the point is waived").

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[9] At the outset, the application of this principle outside the special criminal context should not be assumed. "The Sixth Amendment requires more than appellate speculation about a hypothetical jury's action, or else directed verdicts for the State would be sustainable on appeal; it requires an actual jury finding of guilty." *Sullivan v. Louisiana*, 508 U.S. 275, 280 (1993).

CONCLUSION

The petition for writ of certiorari should be denied.

Respectfully submitted,

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